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In re Application of   :   **OFFICE OF PETITIONS**
Tipton et al.   :
Application No. 10/672,311   :   DECISION ON PETITION
Filed: September 26, 2003   :   UNDER 37 CFR 1.78(a)(6)
Attorney Docket No. NOVLP075/NVLS-   :
000820

This is a decision on the petition under 37 CFR 1.78(a)(6), filed July 10, 2006, to accept an unintentionally delayed claim under 35 U.S.C. § 119(e) for the benefit of priority to a prior-filed provisional application.

The petition is **DISMISSED.**

A petition under 37 CFR 1.78(a)(6) is only applicable to those applications filed on or after November 29, 2000. Further, the petition is appropriate only after expiration of the period specified in 37 CFR 1.78(a)(5)(ii) and must be filed during the pendency of the nonprovisional application. In addition, the petition must be accompanied by:

(1)   the reference required by 35 U.S.C. § 119(e) and 37 CFR 1.78(a)(5)(i)
           to the prior-filed application, unless previously submitted;
(2)   the surcharge set forth in § 1.17(t); and
(3)   a statement that the entire delay between the date the claim was due
           under 37 CFR 1.78(a)(5)(ii) and the date the claim was filed was
           unintentional. The Director may require additional information
           where there is a question whether the delay was unintentional.

This pending nonprovisional application was filed on September 26, 2003, within twelve months of the filing date of the prior-filed provisional application, Application No. 60/469,433 which was filed on May 9, 2003 and for which priority is claimed.

The amendment as drafted is unacceptable and, therefore, is not considered a proper reference under 37 CFR 1.78(a)(2)(i). In this regard, the amendment is physically part of the petition and, as such, does not comply with 37 CFR 1.121, 1.52, or 1.4(c). Note that 37 CFR 1.121 states that amendments are made by filing a paper, in compliance with § 1.52, directing that specified amendments be made. The pertinent section of 37 CFR 1.52 states that the claim (in this case, the claim for priority), must commence on a separate physical sheet. 37 CFR 1.4(c) states that

each distinct subject must be contained in a separate paper since different matters may be considered by different branches of the United States Patent and Trademark Office.

Further, the amendment is not acceptable as drafted since it improperly incorporates by reference the prior-filed application. An incorporation by reference statement added after an application's filing date is not effective because no new matter can be added to an application after its filing date (*see* 35 U.S.C. § 132(a)). If an incorporation by reference statement is included in an amendment to the specification to add a benefit claim under 35 U.S.C. § 120 after the filing date of the application, the amendment would not be proper. When a benefit claim under 35 U.S.C. § 120 is submitted after the filing of an application, the reference to the prior application cannot include an incorporation by reference statement of the prior application. *See* Dart Industries v. Banner, 636 F.2d 684, 207 USPQ 273 (C.A.D.C. 1980). *Note* MPEP §§ 201.06(c) and 608.04(b).

Accordingly, before the petition under 37 CFR 1.78(a)(6) can be granted, a renewed petition under 37 CFR 1.78(a)(6) and either an Application Data Sheet or a substitute amendment (complying with 37 CFR 1.121 and 37 CFR 1.76(b)(5)) deleting the incorporation by reference statement, are required.
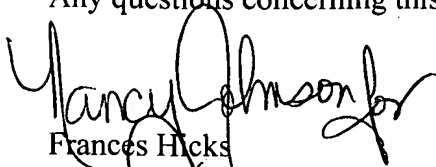
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Any questions concerning this matter may be directed to Charlema Grant at (571) 272-3215.

Frances Hicks
Petitions Examiner
Office of Petitions